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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,994	07/30/2003	William Annacone	31701-DIV	9140
7590 05/27/2004				
RICHARD K. WARTHER		EXAMINER		
Allen, Dyer, Doppelt, Milbrath & Gilchrist, P.A.		DUDDING, ALFRED E		
P.O. Box 3791		ART UNIT		
Orlando, FL 32802-3791		2853		
		PAPER NUMBER		

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



**Office Action Summary**

Application No.

10/629,994

Applicant(s)

ANNAcone, WILLIAM

Examiner

Alfred E. Dudding

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17, 18 and 41-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17, 18, 41-44 and 53-59 is/are allowed.
- 6) ☒ Claim(s) 45-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 July 2004 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/30/03</u>   | 6) <input type="checkbox"/> Other: _____                                    |



**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 45 –48 and 50 - 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Sweatt (U.S. 5,729,365 A).

Sweatt discloses a currency substrate, Column 5, lines 51 - 52; and a metallization layer applied over a portion of surface the currency substrate, Column 1, lines 42- 45, and having been etched to form a unique bill specific identification for the bill on which it is applied, Column 1, lines 45 - 48, Column 5, lines 56 – 58.

Sweatt discloses:

- a. that the bill specific identification further comprises a hologram, Abstract, lines 3 – 7,
- b. that the bill further comprises a substantially translucent protective layer received on the metallization layer, Column 5, lines 32 – 34,
- c. that the currency substrate comprises flexible paper, and that the bill has an adhesive layer comprises a heat activated adhesive, Column 5, line 67 – Column 6, lines 1 -3.



***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sweatt in view of Ferro (U.S. 6,506,315 B2).

Sweatt teaches all of the limitations of the claimed invention except for a currency bill wherein said metallization layer comprises a vacuum metallized layer.

Ferro discloses a metallized foil having a layer that is vacuum deposited, Column 2, lines 40 - 44

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use metallized foil of Ferro as the metallized layer of Sweatt applied to a currency bill for protection against counterfeiting.

***Allowable Subject Matter***

5. The following is a statement of reasons for the indication of allowable subject matter:

a. The primary reason for the allowance of claims 17, 18, and n42 - 44 is the inclusion of the limitation of a currency bill having a currency substrate; wherein the patterned, bill specific metallization layer had been ink jet patterned with an ink having an etchant or etchant-resistant mask and etched to form a bill specific metallization layer having a pattern. It is this limitation found in each of the claims, as it is claimed in the combination, that has not been



Art Unit: 2853


found, taught, or suggested by the prior art of record which makes these claims allowable over the prior art.

b. The primary reason for the allowance of claims 53 - 59 is the inclusion of the limitation of a currency bill having a currency substrate; and a bill specific metallization layer adhesively applied on the substrate, the metallization layer having been ink jet patterned with an ink having an etchant-resistant mask.


### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alfred Dudding whose telephone number is (571) 272-2144. The examiner can normally be reached on Monday-Friday from 8:30 AM to 4:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier, AU 2853, can be reached at (571) 272 - 2149. The fax phone number for this Group is are (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0956.

  
Stephen D. Meier  
Primary Examiner

Alfred Dudding

  
5/24/04